

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Robert R. Parsons : Docket: #0013  
Application No.: 10/811,616 : Examiner: Stroder, Carrie A.  
Filing Date: March 29, 2004 : Art Unit: 3689  
Confirmation No: 2720 : Customer No. 43,699  
Title: **PROCESS FOR REGISTERING AND TRADEMARKING  
DOMAIN NAMES**

**APPEAL BRIEF**

**Real party in interest:**

The Go Daddy Group, Inc.

**Related appeals and interferences:**

Application No. 10/811,677 has been appealed, assigned Appeal No: 2010-002850 and is pending;

Application No. 10/811,678 has received multiple OAs and Amendments; and

Application No. 10/811,615 has received multiple OAs and Amendments.

These three applications all share a common assignee, filing date and disclosure.

**Status of claims:**

Claims 1-19 stand rejected.

Claims 1-19 are being appealed.

**Status of amendments.**

No amendments have been made after the final rejection.

**Summary of claimed subject matter.**

For claim 1:

A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of: **[Specification page 14, second paragraph and Fig. 1]**

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;

**[Specification page 16, first and second full paragraphs and step 200 in Figs. 2 and 3]**

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site; and

**[Specification page 16, last partial paragraph to page 17, first and second full paragraphs and step 201 in Fig. 2 and step 202 in Figs. 2, 5a, 5b and 5c.]**

C) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. **[Specification page 17, second full paragraph and step 207 in Fig. 2]**

For claim 7:

A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of: **[Specification page 14, second paragraph and Fig. 1]**

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;

**[Specification page 16, first and second full paragraphs and step 200 in Figs. 2 and 3]**

B) the Facilitator's web site offering hosting services on a hosting server for an Entrepreneur's web site at an Internet protocol address associated with a domain name registered with a Registry and having a label and a top-level domain; and **[Specification page 20, third paragraph and step 205 in Fig. 2]**

C) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. **[Specification page 17, second full paragraph and step 207 in Fig. 2]**

For claim 13:

A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of: **[Specification page 14, second paragraph and Fig. 1]**

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet; **[Specification page 16, first and second full paragraphs and step 200 in Figs. 2 and 3]**
- B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site; **[Specification page 16, last partial paragraph to page 17, second full paragraphs and step 201 in Fig. 2 and step 202 in Figs. 2, 5a, 5b and 5c.]**
- C) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with the registered domain name; and **[Specification page 17, second full paragraph and step 207 in Fig. 2]**
- D) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. **[Specification page 17, second full paragraph and step 207 in Fig. 2]**

For claim 19:

A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of: **[Specification page 14, second paragraph and Fig. 1]**

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet; **[Specification page 16, first and second full paragraphs and step 200 in Figs. 2 and 3]**
- B) the Facilitator's web site receiving information regarding the Entrepreneur that has accessed the Facilitator's web site; **[Specification page 16, second full paragraph]**
- C) the Facilitator's web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site; **[Specification page 16, second full paragraph]**
- D) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name using at least some of the stored information regarding the Entrepreneur; and **[Specification page 16, second full paragraph to page 17, second full paragraph and step 201 in Fig. 2 and step 202 in Figs. 2, 5a, 5b and 5c.]**
- E) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office using at least some of the stored information regarding the Entrepreneur, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet. **[Specification page 17, second full paragraph and step 207 in Fig. 2]**

**Grounds of rejection to be reviewed on appeal.**

Whether claims 1-3, 7-9, 13-15 and 19 are unpatentable under 35 USC §103 as obvious by Go Daddy, [www.godaddy.com](http://www.godaddy.com), 02 February 2003 (hereinafter "prior Go Daddy service") in view of Chauchard et al. US 20020042719 (hereinafter "Chauchard").

**Argument.**

Claims 1, 7, 13 and 19

**I. Not all limitations taught for claims 1, 7, 13 and 19**

The OA at the bottom of page 2 to the top of page 3 states:

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).  
Go Daddy does not teach; however, Chauchard teaches  
C) assisting the Entrepreneur in trademarking a name, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (paragraphs 75-80).

Appellant respectfully disagrees because there are three limitations in step C of claims 1 and 7, step D of claim 13 and step E of claim 19 that are not taught by the prior Go Daddy service or Chauchard as discussed in detail by sections 1-3 below. Thus, the prior art fails to establish prima facie obviousness, which requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03; In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since at least step C) of claim 1 is not taught or suggested by the prior art, Appellant respectfully requests the withdrawal of this rejection.

**1. Prior art does not teach an “Entrepreneur” that 1) trademarks a domain name or label of the domain name and 2) either registers the domain name or receives an offer for hosting services.**

Chauchard teaches a process for assisting an applicant on a local computer to perform a trademark process. There is no teaching in Chauchard of the trademark applicant registering a domain name or receiving hosting services. Thus, Chauchard does not teach the limitation of an “Entrepreneur” as an “Entrepreneur” in claims 1 and 13, step B) and claim 19, step D) has a domain name registered by a Facilitator’s web site. Chauchard also does not teach the limitation of an “Entrepreneur” as an “Entrepreneur” in claim 7, step B) is offered “hosting services” by a Facilitator’s web site.

The prior Go Daddy service teaches, among other things, a process for assisting a customer to perform a domain name registration process. However, there is no teaching in the prior Go Daddy service of the customer trademarking a domain name or label [of a domain name]. Thus, the prior Go Daddy service also does not teach the limitation of an “Entrepreneur” as an “Entrepreneur” in claims 1 and 7, step C), claim 13, step D) and claim 19, step E) has a domain name or label [of a domain name] trademarked by a Facilitator’s web site.

In contrast to Chauchard and the prior Go Daddy service, claim 1, step C) recites “assisting the Entrepreneur [who has a domain name registered by a Facilitator’s web site in step B)] in trademarking the domain name or the label [of a domain name.] Since neither Chauchard nor Go Daddy teaches the claim limitation of an “Entrepreneur” as defined in claim 1, step B) (registering a domain name) and step C) (trademarking a domain name or label [of a domain name]), the prior art does not teach all the words of the claim.

**2. Prior art does not teach an Entrepreneur “trademarking the domain name or the label” [of a domain name] from a “Facilitator’s web site.”**

The OA on the bottom of page 2 to the top of page 3 states “Chauchard teaches C) assisting the Entrepreneur in trademarking a name,” (underlining added) This is an incomplete statement of claim 1, step C). Claim 1, step C) actually claims “assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]”, not just “a name” as incorrectly stated in the OA.

Chauchard teaches a process for assisting a trademark applicant on a local computer to perform a trademark process. There is no teaching in Chauchard of the applicant trademarking a domain name or the label [of a domain name]. Thus, Chauchard does not teach the limitation of “trademarking the domain name or the label [of a domain name]” as recited in claim 1, step C).

The prior Go Daddy service teaches, among other things, a process for assisting a customer in performing a domain name registration process. However, there is no teaching in the prior Go Daddy service of the customer trademarking anything, let alone a domain name. Thus, the prior Go Daddy service also does not teach the limitation of “trademarking the domain name or the label [of a domain name]” as recited in claim 1, step C).

In contrast to Chauchard and the prior Go Daddy service, claims 1 and 7, step C), claim 13, step D) and claim 19, step E) recite “the Facilitator’s web site assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]” Thus, neither Chauchard nor the prior Go Daddy service teach the claim limitation of trademarking a domain name or the label [of a domain name] from a Facilitator’s web site as recited in all the independent claims (claims 1, 7, 13 and 19).

3. **Prior art does not teach a “Facilitator’s web site” that assists Entrepreneurs in preparing trademark applications AND either registers domain names (claims 1, 13 and 19) or offers hosting services (claim 7).**

Claims 1 and 7, step C), claim 13, step D) and claim 19 E) include the limitation of “the Facilitator’s web site assisting the Entrepreneur in trademarking the domain name or the label [of the domain name].” The Facilitator’s web site also, among other things, registers domain names in claims 1 and 13, step B) and claim 19, step D) and offers hosting services in claim 7, step B).

Some of the advantages of this invention over the prior art are listed on page 9, first three paragraphs. Specifically, by having a Facilitator’s web site coordinate the various steps of creating an Internet business the process is greatly simplified, steps are more likely to be done in the correct order and information entered in an earlier step may be used in later steps, thereby creating synergizes and removing chances of error from prior art methods. The specification on page 9 even states the advantages “may still occur even if the Entrepreneur completes the later steps months or even years later.” These advantages of the processes in independent claims 1, 7, 13 and 19 are not achieved by the prior art systems.

Chauchard teaches a process for assisting an applicant to perform a trademark process. Chauchard does not teach either: 1) “trademarking the domain name or the label” [of a domain name]; or 2) a “Facilitator’s web site” that, in addition to trademarking domain names, also allows domain name registration or offers hosting services.

The prior Go Daddy service teaches, among other things, a process for assisting a customer to perform a domain name registration process. However, there is no teaching in the prior Go Daddy service of its website assisting a customer in trademarking a domain name or label [of a domain name.] Thus, the prior Go Daddy service also does not teach the limitation of “the Facilitator’s web site assisting the Entrepreneur in trademarking the domain name or the label [of a domain name].”

Since neither Chauchard nor the prior Go Daddy service teaches the claim limitation of “the Facilitator’s web site assisting the Entrepreneur in trademarking the domain name or the label [of a domain name]” where the Facilitator’s web site also registers domain names or offers hosting services, Appellant respectfully requests the withdrawal of this rejection.



Claims 2-6, 8-12 and 14-18

Claims 2-6, 8-12 and 14-18 depend from independent claims 1, 7 and 13 respectively which are believed allowable. Thus, claims 2-6, 8-12 and 14-18 should be allowed at least for this reason.

**II. It would not have been obvious to combine the prior Go Daddy service with Chauchard.**

The OA on page 3, second paragraph (and at several other locations) states that it would have been obvious to combine the prior Go Daddy service and Chauchard because it “would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name.” The OA on page 11 states a conclusion of obviousness is proper “so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure.” However, the OA never shows where this motivation can be found in the prior art.

While the motivation is not found in the prior art, the specification on page 14, second paragraph states “[t]he placement of a plurality of tools on a Facilitator’s web site 105 necessary for creating an Internet business greatly assists the Entrepreneur 101 in completing more of the recommended steps and completing the steps in a much shorter time frame than with the ad hoc approach used by Entrepreneurs in the prior art.”

Thus, the motivation to combine cited in the OA is actually first stated in the Appellant’s specification. The OA has not stated where it independently found the same motivation to combine. Thus, it would not have been obvious to combine where the motivation to combine is found only in Appellant’s specification.

**III. Response to the OA’s Response to Arguments**

The OA on page 9 argues that the claims are obvious “based upon a combination of references.” Appellant respectfully disagrees because it cannot be obvious to combine limitations that are never taught in the prior art as discussed in detail above in section I subsections 1-3.

## CONCLUSION

Appellant respectfully submits that the prior Go Daddy service and Chauchard do not teach all the claim limitations as explained above. Specifically, the prior Go Daddy service and Chauchard do not teach: 1) an “Entrepreneur,” 2) trademarking a domain name or label from a Facilitator’s web site, and 3) a “Facilitator’s web site” as those terms are explicitly limited and described in independent claims 1, 7, 13 and 19.

In addition, Appellant respectfully submits that it would not have been obvious to combine the prior Go Daddy service and Chauchard as the Examiner’s motivation appears to come from the present invention’s specification.

Appellant thus requests a decision by the Board reversing the rejections to claims 1-19 by the examiner. Any questions regarding this Appeal should be directed to the undersigned attorney for Appellant at the telephone number or email address listed below.

Respectfully submitted,

**The Go Daddy Group, Inc.**

Date: 10/29/2010

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**Claims appendix**

1. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:
  - A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
  - B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site; and
  - C) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet.
2. The method of claim 1, further comprising the step of the Facilitator's web site assisting the Entrepreneur in selecting an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business.
3. The method of claim 1, further comprising the step of the Facilitator's web site submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines.
4. The method of claim 1, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the step of the Facilitator's web site linking the Entrepreneur with the official web site for the United States Patent and Trademark Office.
5. The method of claim 1, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the steps of the Facilitator's web site receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office.

6. The method of claim 1, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the steps of the Facilitator's web site receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office.

7. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
- B) the Facilitator's web site offering hosting services on a hosting server for an Entrepreneur's web site at an Internet protocol address associated with a domain name registered with a Registry and having a label and a top-level domain; and
- C) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet.

8. The method of claim 7, further comprising the step of the Facilitator's web site assisting the Entrepreneur in selecting and registering an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business.

9. The method of claim 7, further comprising the step of the Facilitator's web site submitting the Entrepreneur's web site located at the Internet protocol address to one or more search engines.

10. The method of claim 7, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the step of the Facilitator's web site linking the Entrepreneur with the official web site for the United States Patent and Trademark Office.

11. The method of claim 7, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the steps of the Facilitator's web site receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office.

12. The method of claim 7, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the steps of the Facilitator's web site receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office.

13. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
- B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site;
- C) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with the registered domain name; and
- D) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet.

14. The method of claim 13, further comprising the step of the Facilitator's web site assisting the Entrepreneur in selecting the domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business.

15. The method of claim 13, further comprising the step of the Facilitator's web site submitting the hosted Entrepreneur's web site to one or more search engines.

16. The method of claim 13, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the step of the Facilitator's web site linking the Entrepreneur with the official web site for the United States Patent and Trademark Office.

17. The method of claim 13, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the steps of the Facilitator's web site receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office.

18. The method of claim 13, wherein the assisting the Entrepreneur in trademarking the domain name or the label includes the steps of the Facilitator's web site receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office.

19. A method for a Facilitator's web site to assist an Entrepreneur in creating an Internet business, comprising the steps of:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet;
- B) the Facilitator's web site receiving information regarding the Entrepreneur that has accessed the Facilitator's web site;
- C) the Facilitator's web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site;
- D) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name using at least some of the stored information regarding the Entrepreneur; and
- E) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office using at least some of the stored information regarding the Entrepreneur, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet.

**Evidence appendix**

None



**Related proceedings appendix**

None